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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/436,076	11/08/99	WAGNER	108617011003

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EXAMINER
FUNDA, K

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 04/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/436,076

Applicant(s)

Wagner et al.

Examiner

Kathleen Kahler Fonda

Group Art Unit

1623

☐ Responsive to communication(s) filed on \_\_\_\_\_☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**☒ Claim(s) 39-63 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.☐ Claim(s) \_\_\_\_\_ is/are rejected.☐ Claim(s) \_\_\_\_\_ is/are objected to.☒ Claims 39-63 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 40-43, 45-54, and 56-60, drawn to methods for treating or inhibiting atherosclerosis associated with a vessel-corrective technique, wherein the agent is an inhibitory protein, an inhibitory peptide, an inhibitory carbohydrate, and inhibitory glycoprotein, a substance obtained from a snake venom, or a substance obtained from a plant extract, classified in Class 514, subclass 2+.
- II. Claims 44, 55, 61, and 62, drawn to a chimeric construct between a P-selectin ligand or fragment thereof and another molecule, and a method of using it to treat or inhibit atherosclerosis associated with a vessel-corrective technique, classified in Class 514, subclass 54+.

The inventions are distinct, each from the other because of the following reasons. The two inventions are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the invention of Group II requires a chimeric construct, which is a patentably distinct agent from any of the agents of Group I.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and/or divergent subject material, restriction for examination purposes as indicated is proper. Furthermore, searches for the two groups would not be coextensive, and would therefore place an undue burden on the Examiner. A reference for one group could not reasonably be expected also to be a reference for the other group.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

If Applicant elects Group I, Applicant is additionally required under 35 U.S.C. 121 to elect for prosecution on the merits a single disclosed species from among (a) inhibitory proteins and peptides, (b) inhibitory carbohydrates, (c)

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inhibitory glycoproteins, (d) substances obtained from snake venom, and (e) substances obtained from a plant extract, to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, of the Group I claims, claims 40-42, 47-53, and 57-60 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or

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admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 39 and 63 will be examined together with whichever group is elected, to the extent that they read on the elected group and species.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see <http://pto-ebc.uspto.gov> for more information. Also, <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm> may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached on Monday and Friday afternoons, and on Tuesday and Thursday mornings. If the Examiner cannot be

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reached, questions may be addressed to Supervisory Patent Examiner Gary Geist at (703) 308-1701. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.



Kathleen Kahler Fonda, Ph.D.  
Primary Examiner  
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